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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/717,255
Filing Date: November 19, 2003
Appellant(s): RAGER ET AL.

ROLAND K. BOWLER II (#33,477)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed January 4, 2010 appealing from the Office action mailed June 7, 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5839069

KESHAVACHER, ET AL 11/17/98

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 2, 12, 14-16, 19, and 20, are rejected under 35 U.S.C. 102(b) as being clearly anticipated by **Keshavachar, et al.**

Regarding claims 1, 12, 14, 19 and 20, **Keshavacher, et al** a method in a wireless communications device ("*The present invention relates generally to cellular telephones, and more particularly to a system and method for optimizing the rate at which a mobile station telephone conducts a search for its home network.*"), the method comprising: operating in a network other than a home network of the wireless communications device ("*It is desirable that the mobile station user communicates through their HPLMN. The cost of making calls through the network is known when a mobile station is connected to other users through the HPLMN. When the mobile station uses other PLMNs charges may vary, and the user may be unaware of higher costs as the call is being made. The HPLMN may also offer special services to its subscribers that are unavailable on other PLMNs. Such services include call forwarding and call barring. It is possible the mobile station, as it travels, will acquire another PLMN, other than the HPLMN, and remain with this network long after the mobile station has moved back within range of the HPLMN. As a result, mobile stations may visit PLMNs that are not the HPLMN more often than is necessary.*")

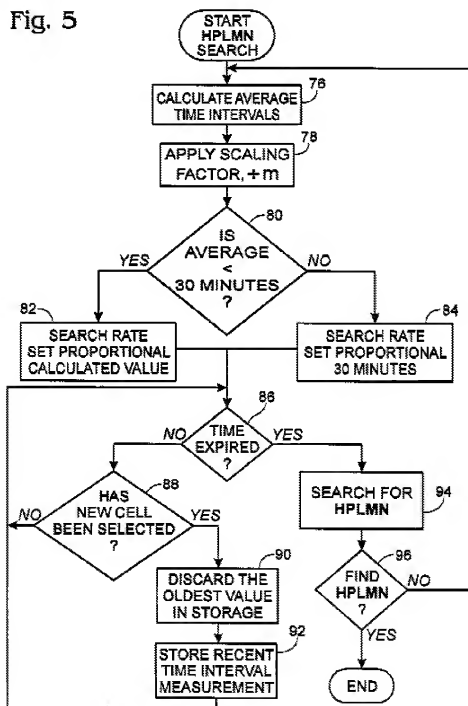
U.S. Patent

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Fig. 5



Determining whether to search for the home network of the wireless communications device when not operating in the home network by comparing network record information associated with the network in which the mobile wireless communications device is operating to reference information (*"In step 104 it is determined whether the mobile station needs to register with the network. The PLMNs of the GSM system provide a mobile station location registration function. In order for the phone system to locate mobile stations not already using a dedicated channel, a mobile station must identify which cell it has selected. This situation often occurs when the mobile station has been turned off for a period of time so that the system has no record of the mobile station's present location. The location information is important since the network may be required to direct a communication to the user of the mobile station from another phone user. If registration is necessary, the process continues to step 106 where the location updating function is performed.*

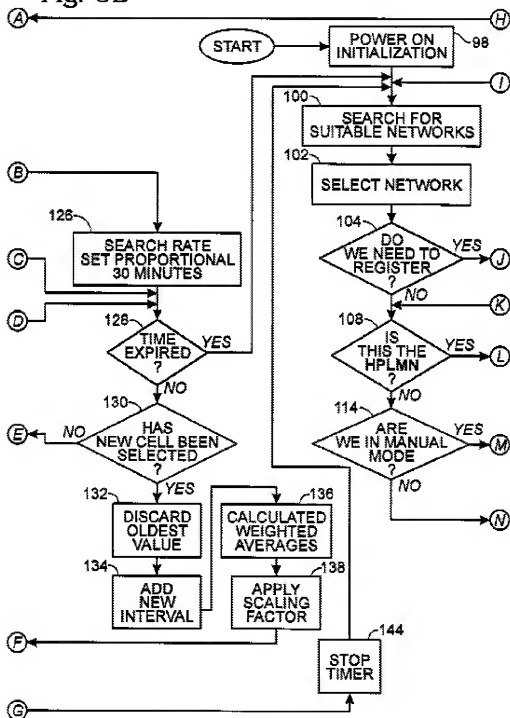
U.S. Patent

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Fig. 6B



"In step 108 the mobile station determines whether the network selected is the HPLMN. If, in step 108, the HPLMN has been located, the process continues to a step 110 in which the mobile station locks on to, or "camps", on the PLMN it has selected. The mobile station continues to be camped on the PLMN until a loss of signal occurs in step 112. A loss of signal occurs when the mobile station is unable to adequately communicate through any of the cells in the selected PLMN. When a loss of signal occurs the process returns to step 100 to search for a suitable network.")

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Fig. 6C

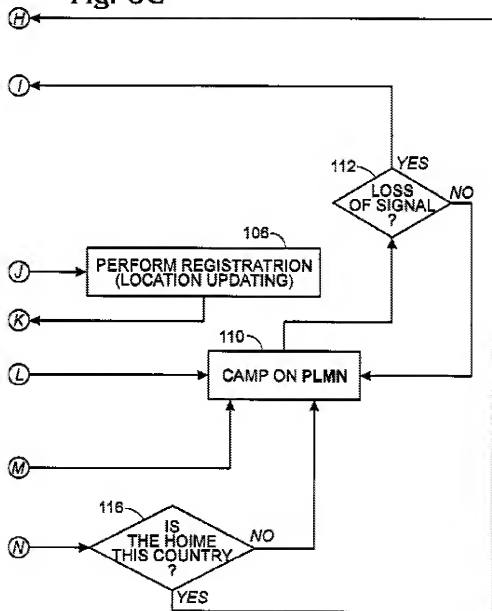


Fig. 6A	Fig. 6B	Fig. 6C
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Regarding claims 2 and 15, **Keshavachar, et al** discloses *"In addition to searching for proximate cells, the mobile station also makes searches for its Home Public Land Mobile Network (HPLMN). The HPLMN is the network with which the mobile user has a subscription relationship, the network with which the mobile user prefers to do business. In the automatic network selection mode the mobile station automatically attempts to select and register with the HPLMN. In the manual network selection mode the HPLMN is usually one of several selectable PLMNs. Examples of cellular phone systems requiring a HPLMN search are the Global System for Mobile Communications (GSM) System, Personal Communications Service at 1900 Mhz (PCS 1900), and the Digital Cellular System at 1800 Mhz (DCS 1800). More details of the GSM system can be found in the text, "The GSM System for Mobile Communications" by Michel Mouly and Marie-Bernadette Paulet, Mouly and Paulet, 1992. GSM cellular phone systems are operated in accordance with a set of comprehensive specifications. GSM 02.11 of the European Telecommunications Standard for GSM cellular telephones specifies that the mobile station shall make attempts to return to its HPLMN when visiting another PLMN. A value of 30 minutes between home network searches is listed in the specification. The specification also includes a note warning that use of values of less than 30 minutes may result in excessive battery drain."*

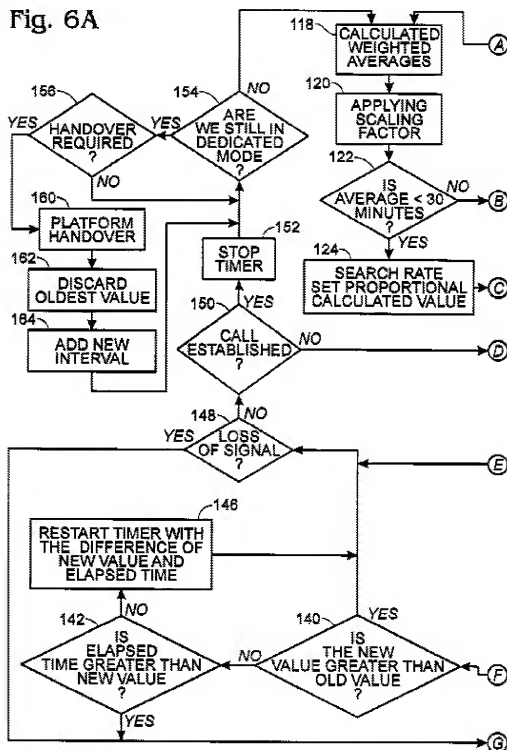
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Fig. 6A



Regarding "indicating" step like claim 12, **Keshavachar, et al** clearly disclose **indicates** or stating or to express, especially briefly or in a general way or a signal that the wireless communications device is operating in a network other than the network in which the wireless communications device is operating based on the network record information (note the above paragraphs, figure 5, #96, figure 6c #116, figure 6B, #108, etc.)

Also for claims like claim 15, note the above paragraphs, figure 5, #96, figure 6c #116, figure 6B, #108, for example *"If, in step 88, no new cells have been selected then the process returns to step 86 to determine if time has expired. If, in step 86, it has been determined that time has expired, the process continues to a step 94 which initiates the step of searching for the HPLMN. In step 96 it is determined whether the HPLMN has been found. If, in step 96, the HPLMN has not been found, the process returns to step 76 to calculate an average time interval. If, in step 96, the HPLMN has been found, the process comes to an end."*

Regarding claims like 20 and "roaming" this is clearly shown by **Keshavachar, et al** as the wireless communication device roams through a network or a plurality of networks as stated by the Abstract, *"A method is provided for a mobile station to calculate the time intervals at which it monitors cells in a cellular phone system to find the mobile station's home network in the phone system. The monitoring varies with the rate at which the mobile station reselects proximate cells to locate itself in a telephone network. The time*

between cell selections is used as an indication of the mobile station's mobility. The variable search intervals, determined by the time intervals at which the mobile station reselects cells, is limited to insure that the mobile station at least monitors for its home network at a minimum specified interval of time. An apparatus is also provided to initiate home network monitoring at time intervals related to rate at which cells in a cellular phone system are reselected by a mobile station."

(10) Response to Argument

Anticipatory reference need not duplicate, word for word, what is in claims; anticipation can occur when claimed limitation is "*inherent*" or otherwise implicit in relevant reference (Standard Havens Products Incorporated v. Gencor Industries Incorporated, 21 USPQ2d 1321). During examination before the Patent and Trademark Office, claims must be given their broadest reasonable interpretation and limitations from the specification may not be imputed to the claims (Ex parte Akamatsu, 22 USPQ2d, 1918; In re Zletz, 13 USPQ2d 1320, In re Priest, 199 USPQ 11). In response to Appellants' argument, the law of anticipation requires that a distinction be made between the invention described or taught and the invention claimed. It does not require that the reference "*teach*" what the subject patent teaches. Assuming that a reference is properly "*prior art*," it is only necessary that the claims under consideration "*read on*" something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or "*fully met*" by it. It was held in In re Donohue, 226 USPQ 619, that,

"It is well settled that prior art under 35 USC §102(b) must sufficiently describe the claimed invention to have placed the public in possession of it...Such possession is effected if one of ordinary skill in the art could have combine the description of the invention with his own knowledge to make the claimed invention." Clear inference to the artisan must be considered, In re Preda, 159 USPQ 342. A prior art reference must be considered together with the knowledge of one of ordinary skill in the pertinent art, In re Samour, 197 USPQ 1. During patent examination, the pending claims must be *"given the broadest reasonable interpretation consistent with the specification."* Claim term is not limited to single embodiment disclosed in specification, since number of embodiments disclosed does not determine meaning of the claim term, and applicant cannot overcome *"heavy presumption"* that term takes on its ordinary meaning simply by pointing to preferred embodiment (*Teleflex Inc. v. Ficosa North America Corp.*, CA FC, 6/21/02, 63 USPQ2d 1374). Appellants always had the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA1969). *"Arguments that the alleged anticipatory prior art is nonanalogous art' or teaches away from the invention' or is not recognized as solving the problem solved by the claimed invention, [are] not germane' to a rejection under section 102."* *Twin Disc, Inc. v. United States*, 231 USPQ 417, 424 (Cl. Ct. 1986) (quoting *In re Self*, 671 F.2d 1344, 213 USPQ 1, 7 (CCPA 1982)). A reference is no less anticipatory if, after disclosing the invention, the reference then disparages it. The question whether a reference *"teaches away"* from the

invention is inapplicable to an anticipation analysis. *Celeritas Technologies Ltd. v. Rockwell International Corp.*, 150 F.3d 1354, 1361, 47 USPQ2d 1516, 1522-23 (Fed. Cir.1998).

Appellants are view their claims ultra narrowly. Their argument seems their claim comes down on word "*whether*." The common meaning of the term "*whether*" is a conjunction that is used to introduce a single alternative, the other being implied or understood, or some clause or element not involving alternatives (www.dictionary.com).

Keshavachar, et al clearly disclose determining whether to search for the home network of the wireless communications device when not operating in the home network by comparing network record information associated with the network in which the mobile wireless communications device is operating to reference information by "*This situation often occurs when the mobile station has been turned off for a period of time...*" or "*If registration is necessary, the process continues to step 106 where the location updating function is performed,*" or "*When a loss of signal occurs the process returns to step 100 to search for a suitable network.*" There are also other conditions where **Keshavachar, et al** clearly determines whether to search for the home network of the wireless communications device when not operating in the home network by comparing network record information associated with the network in which the mobile wireless communications device is operating to reference information.

In response to Appellants' argument that the references includes additional structure or functions not required by Appellants' invention, it must be noted that the references disclose the invention as claimed. The fact that it discloses additional structure or functions not claimed is irrelevant.

Regarding claims like claim 12, the plain meaning of "*indicating*" is to state or express, especially briefly or in a general way or a signal. **Keshavachar, et al** clearly disclose stating or to express, especially briefly or in a general way or a signal that the wireless communications device is operating in a network other than the network in which the wireless communications device is operating based on the network record information (note the above paragraphs, figure 5, #96, figure 6c #116, figure 6B, #108, etc.)

Also for claims like claim 15, note the above paragraphs, figure 5, #96, figure 6c #116, figure 6B, #108, for example "*If, in step 88, no new cells have been selected then the process returns to step 86 to determine if time has expired. If, in step 86, is has been determined that time has expired, the process continues to a step 94 which initiates the step of searching for the HPLMN. In step 96 it is determined whether the HPLMN has been found. If, in step 96, the HPLMN has not been found, the process returns to step 76 to calculate an average time interval. If, in step 96, the HPLMN has been found, the process comes to an end.*"

The plain meaning of "*roaming*" is to walk, go, or travel without a fixed purpose or direction. This is clearly shown by **Keshavachar, et al** as the wireless communication device roams through a network or a plurality of networks as stated by the Abstract, "A

method is provided for a mobile station to calculate the time intervals at which it monitors cells in a cellular phone system to find the mobile station's home network in the phone system. The monitoring varies with the rate at which the mobile station reselects proximate cells to locate itself in a telephone network. The time between cell selections is used as an indication of the mobile station's mobility. The variable search intervals, determined by the time intervals at which the mobile station reselects cells, is limited to insure that the mobile station at least monitors for its home network at a minimum specified interval of time. An apparatus is also provided to initiate home network monitoring at time intervals related to rate at which cells in a cellular phone system are reselected by a mobile station."

Again, Appellants are taking claims ultra narrowly and not taking plain meaning of their claims. The Examiner is only examining the claims as broadly as Appellants are claiming their invention.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/WILLIAM D CUMMING/

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